

U.S. Patent Application No.: 09/817,459
Art Unit: 1712
Page 2

REMARKS

Summary of the Invention and Pending Claims

The present invention relates to organically modified aerogels and lyogels and to processes for preparing them by surface modification of an aqueous gel, without prior solvent exchange.

Claims 2-4, 6, 7, 56-59, 62, 63, 67-69, 71, 76, 77, 79-115, and 117-119 are pending. However, Applicants note that, in the Office Action Summary, item 4 (Disposition of Claims) does not include claim 59, which Applicants believe is pending. Furthermore, Applicants note that some of the rejections include claim 59 in the listing of claims rejected under 35 U.S.C. § 102, but not all of the rejections include this claim even though the same reference is cited. Clarification is requested. For the purposes of this response, Applicants have assumed that the claims indicated in each rejection are correct.

Rejection of Claims under 35 U.S.C. § 102(a)

The Examiner has rejected claims 2-4, 6, 56-58, 76-77, 79-80, 86, 88, 91-92, 94, 97, 99-102, 104-106, 115, and 117-119 under 35 U.S.C. § 102(a) as being anticipated by Hoechst (WO97/03017) as evidenced by Schwertfeger et al. (U.S. Patent No. 6,159,539).

In paragraph 3 of the Final Office Action, the Examiner points out that Hoechst is a patent family member of Schwertfeger et al. and is considered as an English translation of Hoechst. The Examiner states that, while the rejection is based on Hoechst, citations will be used from Schwertfeger et al., and specific sections relating to the additives and the pH of the initial charge for modification are referenced.

Applicants respectfully disagree with this rejection. Applicants wish to point out that, pursuant to 35 U.S.C. § 371, the present application is a national phase application of International Patent Application No. PCT/EP97/06595, filed on November 26, 1997. This

U.S. Patent Application No.: 09/817,459
Art Unit: 1712
Page 3

international application claims priority to German Patent Application No. 196 48 798.6, filed November 26, 1996, and the claims of the present application are supported by this priority document.

For the purposes of 35 U.S.C. § 102(a), the earliest date for Hoechst (an international patent publication) would be its publication date, which is January 30, 1997. Therefore, Hoechst is not a prior art document under 35 U.S.C. § 102(a) since it was not described in a printed publication in this or a foreign country prior to the invention by the applicants. In view of this, Applicants previous arguments concerning Hoechst are hereby fully retracted.

Applicants therefore believe that claims 2-4, 6, 56-58, 76-77, 79-80, 86, 88, 91-92, 94, 97, 99-102, 104-106, 115, and 117-119 are not anticipated by Hoechst (WO97/03017) as evidenced by Schwertfeger et al. (U.S. Patent No. 6,159,539), and respectfully request the rejection under 35 U.S.C. § 102(a) be withdrawn.

Rejection of Claims under 35 U.S.C. § 102(e)

The Examiner has rejected claims 2-4, 6, 56-58, 76-77, 79-80, 86, 88, 91-92, 94, 97, 99-102, 104-106, 115, and 117-119 under 35 U.S.C. § 102(e) as being anticipated by Schwertfeger et al. (U.S. Patent No. 6,159,539).

In paragraph 4 of the Final Office Action, the Examiner references the preceding rejections and notes that the applied reference has a common inventor with the present application. The Examiner concludes that, based on the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. § 102(e).

Applicants respectfully disagree. Schwertfeger et al. is a U.S. patent resulting from International Patent Application No. WO97/03017, filed July 2, 1996. As pointed out by the Examiner in paragraph 2 of the Final Office Action, the changes made to 35 U.S.C. § 102(e) do not apply "when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000". As such, the prior art date of the reference would be determined under 35 U.S.C. § 102(e) prior to the amendment by the AIPA.

U.S. Patent Application No.: 09/817,459

Art Unit: 1712

Page 4

Thus, the 102(e) date for Schwertfeger et al. is the earlier of the date of completion of the requirements of 35 U.S.C. § 371(c)(1), (2), and (4), or the filing date of the U.S. application (see MPEP 706.02(a) and 706.02(f)), which would be January 8, 1998 as evidenced by item [86] on the front page of this patent. For convenience, Applicants herein include a copy of the flowcharts for determining 35 U.S.C. § 102(e) dates from MPEP 706.02(f)(1).

By comparison, as noted above, pursuant to 35 U.S.C. § 371, the present application is a national phase application of International Patent Application No. PCT/EP97/06595, filed on November 26, 1997. Therefore, Schwertfeger et al. is not a prior art document under 35 U.S.C. § 102(e) since it was not described in a patent granted on an application by another filed in the U.S. prior to the invention by the applicants. In view of this, Applicants previous arguments concerning Schwertfeger et al. are hereby fully retracted.

Applicants therefore believe that claims 2-4, 6, 56-58, 76-80, 86, 88, 91-92, 94, 97, 99-102, 104-106, 115, and 117-119 are not anticipated by Schwertfeger et al. (U.S. Patent No. 6,159,539), and respectfully request the rejection under 35 U.S.C. § 102(e) be withdrawn.

Rejection of Claims under 35 U.S.C. § 102(f)

The Examiner has rejected claims 2-4, 6, 56-59, 76-77, 79-80, 86, 88, 91-92, 94, 97, 99-102, 104-106, 115, and 117-119 under 35 U.S.C. § 102(f) because Applicants did not invent the claimed subject matter.

In paragraph 5 of the Final Office Action, the Examiner states that Schwertfeger et al. (U.S. Patent No. 6,159,539) is directed to a different inventive entity and references the preceding rejections.

Applicants respectfully disagree with this rejection. As discussed in more detail above, Schwertfeger et al. is not a prior art reference under 35 U.S.C. § 102. Furthermore, to the best of Applicants' knowledge, the inventors were correctly named on this application at the time of filing. Since the claimed subject matter of Schwertfeger et al. is not identical to the claimed subject matter of the present application, it is appropriate that different inventive entities are also

U.S. Patent Application No.: 09/817,459
Art Unit: 1712
Page 5

named. Therefore, Applicants respectfully request that the rejection under 35 U.S.C. § 102(f) be withdrawn.

Rejection of Claims under 35 U.S.C. § 103

In paragraphs 6 and 7 of the Final Office Action, the Examiner has included a rejection of claims under 35 U.S.C. § 103(a) but has not indicated which claims are rejected and which references are considered. Applicants believe this rejection was included in error. Clarification is requested.

Double Patenting

The Examiner has provisionally rejected claims 2-4, 6-7, 56-58, 62-63, 67-69, 71, 76-77, 79-115, and 117-119 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6-24 of copending U.S. Patent Application No. 09/308,770.

In paragraph 9 of the Final Office Action, the Examiner states that, although the conflicting claims are not identical, they are not patentably distinct from each other. The Examiner further states that the methods substantially overlap since the instant claimed methods and the copending methods both employ the open transitional language "comprising" and since the generic terms "lyogel" and "hydrogel" further overlap.

In paragraph 12 of the Final Office Action, the Examiner has noted Applicants request to hold this provisional obviousness-type double patenting rejection in abeyance because the conflicting claims have not in fact been patented.

U.S. Patent Application No.: 09/817,459

Art Unit: 1712

Page 6

Conclusion

In view of the foregoing remarks, Applicants believe that this application is considered to be in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would further expedite the prosecution of the subject application, the Examiner is invited to call the undersigned.

Respectfully submitted,



Robert M. Amici
Reg. No. 52,554
CABOT CORPORATION
Law Department
157 Concord Road
Billerica, MA 01821
(978) 670-6191

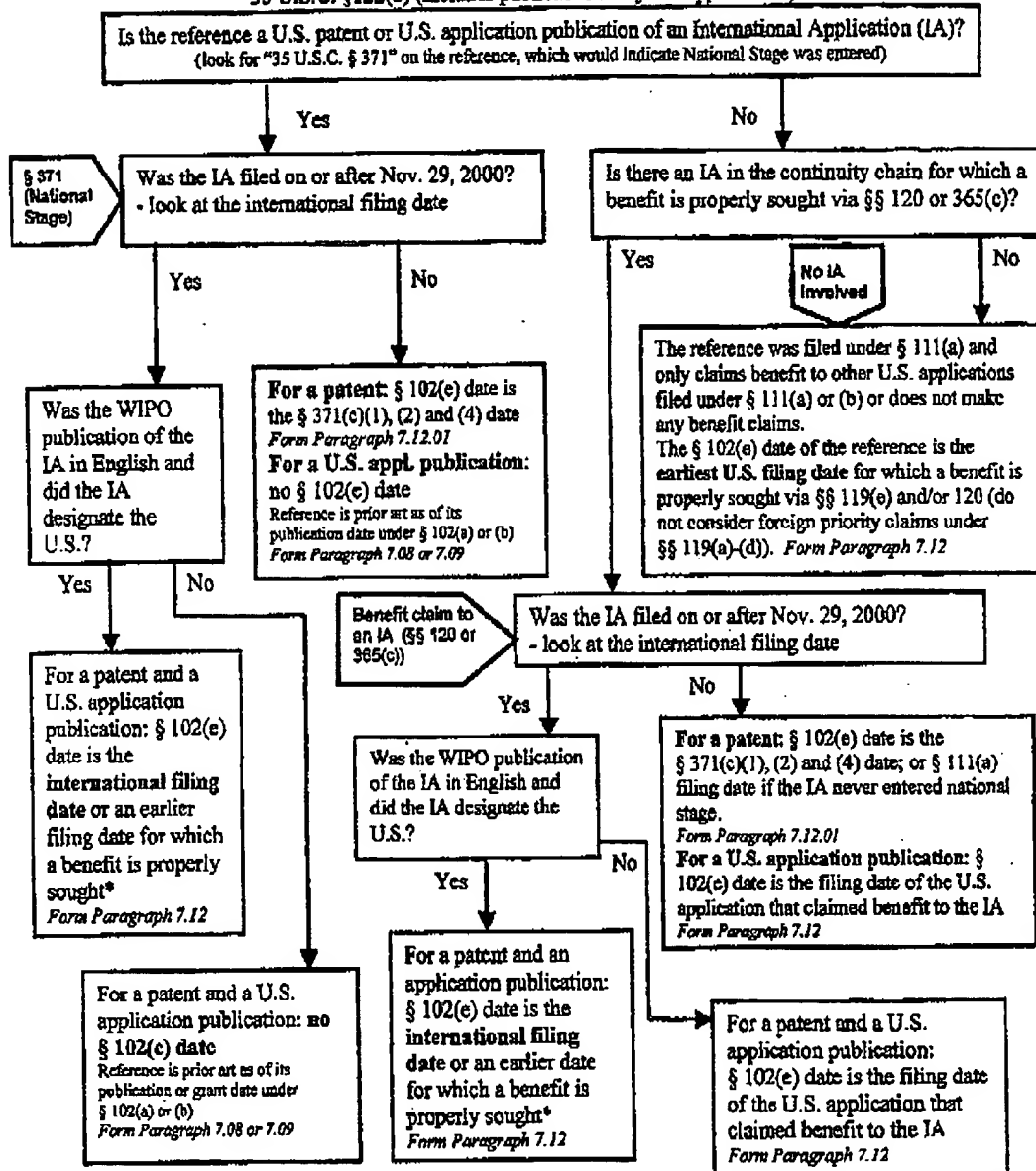
Date: August 1, 2005

Attorney Docket No.: HOE96/F319CON

EXAMINATION OF APPLICATIONS

706.02(1)(1)

III. FLOWCHARTS

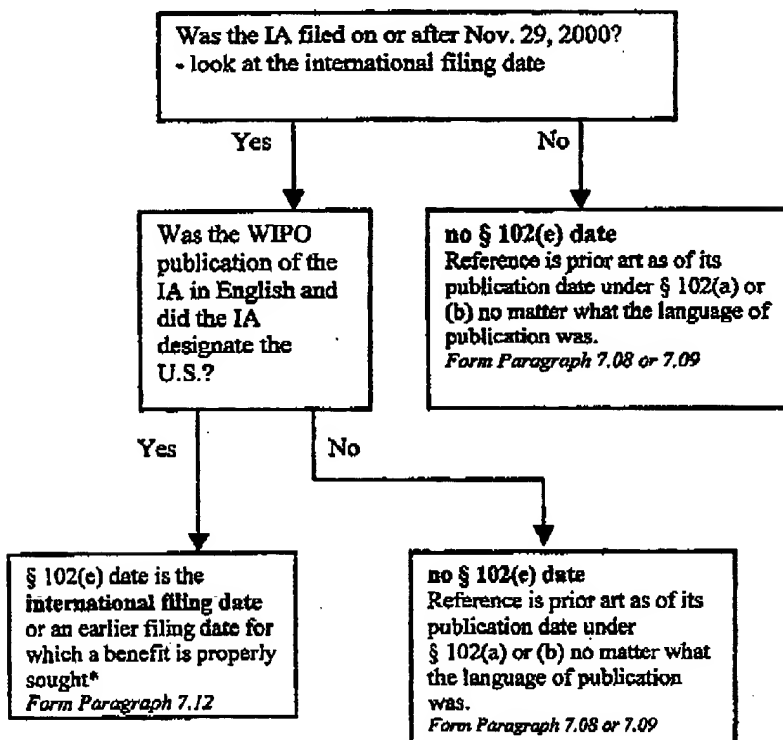
FLOWCHARTS FOR 35 U.S.C. § 102(e) DATES:**Apply to all applications and patents, whenever filed****Chart I: For U.S. patent or U.S. patent application publication under 35 U.S.C. § 122(b) (includes publications of § 371 applications)**

* Consider benefit claims properly made under § 119(e) to U.S. provisional applications, § 120 to U.S. nonprovisional applications, and § 365(c) involving IAs. Do NOT consider foreign priority claims.

706.02(f)(1)

MANUAL OF PATENT EXAMINING PROCEDURE

FLOWCHARTS FOR 35 U.S.C. § 102(e) DATES:
Apply to all applications and patents, whenever filed
Chart II: For WIPO publication of International Applications (IAs)



* Consider benefit claims properly made under § 119(e) to U.S. provisional applications, § 120 to U.S. nonprovisional applications, and § 365(c) involving IAs. Do NOT consider foreign priority claims.

Glossary of Terms:

U.S. patent application publication = pre-grant publication by the USPTO under 35 U.S.C. § 122(b)
International application (IA) = an application filed under the Patent Cooperation Treaty (PCT)
§ 371 application = an IA that has entered the national stage in the U.S. (35 U.S.C. § 371(c)(1), (2) and (4))
November 29, 2000 = the effective date for the amendments to §§ 102(e) and 374
WIPO = World Intellectual Property Organization
WIPO Publication = a publication of an IA under PCT Article 21(2) (e.g., Publication No. WO 99/12345)
§ 111(a) = provision of the patent code that states the filing requirements for nonprovisional applications
§ 111(b) = provision of the patent code that states the filing requirements for provisional applications
§ 119(e) = provision of the patent code that allows for priority claims to provisional applications
§ 119(a)-(d) = provision of the patent code that allows for priority claims to foreign applications
§ 120 = provision of the patent code that allows for benefit claims to nonprovisional applications
§ 365(c) = provision of the patent code that allows for benefit claims to international applications